

REMARKS

Summary of the Amendment

Upon entry of the above amendment, claims 1 and 5 will have been amended. Accordingly, claims 1-24 will be pending, with claims 1, 5, 11, 16 and 23 being independent.

Summary of the Official Action

In the instant Office Action, the Examiner rejected claims 1-24 over the art of record. By the present amendment and remarks, Applicant submits that the objections and rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Interview of July 29, 2004

Applicant appreciates the courtesy extended by Examiner Deane in the interview of July 29, 2004. In that interview, Applicant's representative discussed, among other things, that the features of claims 1, 5, 11, 16 and 23, were not disclosed or suggested by the applied documents.

Applicant's representative also pointed out that the Examiner has not identified any language in YAMANE which discloses or suggests the storing of both public and private data lists on a telephone, much less, that a user can access both types upon entry of a personal

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secret code, otherwise the user can access the public data list and is prevented from accessing private data list. Finally, Applicant's representative pointed out that YAMANE, as best understood, merely teaches the using a phone which stores identification codes in the form of private and public subscriber numbers, and that these numbers are used to access or connect to private or public base stations (see col. 8, lines 14-64).

In response, the Examiner indicated that he was reading the claims and the prior art disclosures in their broadest light. However, the Examiner did agree to reconsider the rejections in light of Applicant's arguments and to discuss the same with his supervisor.

Accordingly, Applicant herein requests reconsideration of the instant rejections and allowance of the pending claims in view of the arguments advanced in the above-noted Interview.

Present Amendment is proper for entry

Applicant submits that the instant amendment is proper for entry after final rejection. Applicant notes that no question of new matter nor are any new issues raised in entering the instant amendment of the claims and that no new search would be required, especially since the claim changes are non-substantive and formal in nature, i.e., a minor change has been made to claim 1 and claim 5 has been essentially rewritten in independent form.

Moreover, Applicant submits that the instant amendment places the application in

condition for allowance, or at least in better form for appeal.

Accordingly, Applicant request that the Examiner enter the instant amendment, consider the merits of the same, and indicate the allowability of the present application and each of the pending claims.

Traversal of Rejection Under 35 U.S.C. § 102

Applicant traverses the rejection of claims 1-9, 11, 12, 16-19, 23 and 24 under 35 U.S.C. § 102(b) as being anticipated by US patent 5,884,200 to YAMANE et al.

The Examiner asserted that this document discloses all the features recited in these claims including the storing of public data and private data on a telephone. Applicant respectfully traverses this rejection.

Notwithstanding the Examiner's assertions as to what this document discloses, Applicant submits that this document fails to disclose, or even suggest: inter alia, storing telephone data related to at least one of incoming and outgoing telephone calls in a list, the telephone data at least including public telephone data, *limiting list access to the public telephone data in the list, until such time as a user of the telephone inputs a personal secret access code, after which, the user has access to the public telephone data in the list of public telephone data and to private telephone data in a list of private telephone data that is associated with the inputted personal secret access code*, wherein both the private telephone

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data and the public telephone data are stored in the telephone, as recited in amended claim 1; inter alia, a memory that stores telephone data related to at least one of incoming and outgoing telephone calls and a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code, access to said stored telephone data being limited to a public list containing public telephone data, until such time as the user enters said personal secret access code, after which, the user has access to said public telephone data contained in said public list and a private list containing private telephone data that is associated with said inputted personal secret access code, wherein both the private telephone data and the public telephone data are stored in the telephone, as recited in amended claim 11; inter alia, entering a personal secret access code into the telephone by a user of the telephone, creating a private list containing telephone numbers associated with the personal secret access code entered by the user, the telephone numbers contained in the private list being accessible after entry of the associated personal secret access code, and creating a public list containing telephone numbers that is accessible by any user of the telephone without the need for entering a personal secret access code, wherein the telephone numbers in both the private list and the public list are stored in the telephone, as recited in amended claim 16; and inter alia, storing in the telephone public type of telephone data related to at least one of incoming and outgoing telephone calls, storing in the telephone, for each of the plurality of users, private type of telephone data related to at least one of

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incoming and outgoing telephone calls, allowing each of the plurality of users to access to the public type of telephone data, preventing each of the plurality of users from accessing the private type of telephone data until each of the plurality of users enters a personal secret access code, allowing one of the plurality of users to access the private type of telephone data upon input of a personal secret access code, and allowing another of the plurality of users to access the private type of telephone data upon input of a personal secret access code, wherein each of the plurality of users has a different personal secret access code, and wherein the private type of telephone data that is accessible by the one of the plurality of users comprises telephone data that is different from the private type of telephone data that is accessible by the other of the plurality of users as recited in amended claim 23.

As explained in the Interview, the present invention, by way of background, permits multiple individuals to use a common telephone, while providing for the maximum privacy of each user's personal data. It also provides for the display and use of the stored public data by all of the users of the telephone. Access to stored private data is allowed only after a personal secret access code is entered into the telephone. Users may have a personal secret access code that is associated with a particular (specific) user of a plurality of users of the telephone. In this way, the private data associated with the specific user of the telephone (as identified by the inputted secret access code) will be made available to that individual.

Applicant notes that YAMANE is clearly not directed to a telephone which can be

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used by multiple individuals, while providing for the maximum privacy of each user's personal data. Moreover, unlike the instant invention, the telephone in YAMANE does not store both private data and public data lists in the telephone itself. Instead, the disclosed telephone system apparently utilizes a phone which communicates with either public or private base stations based on public or private subscriber numbers (see col. 8, lines 14-34). Thus, the disclosed telephone merely has the ability to access different base stations based on subscriber numbers.

Furthermore, while Fig. 6 and col. 7, lines 1-7 of YAMANE discloses the use of two ID memories 22 and 23 that store identification codes, such devices 22 and 23 are merely used to communicate with the TDMA processing station 5 (see col. 7, lines 17-25). There is no apparent disclosure in YAMANE indicating that the devices 22 and 23 can be used to store private and public data lists, nor has the Examiner identified any such disclosure.

Applicant emphasizes that YAMANE clearly fails to disclose or suggest storing telephone data related to at least one of incoming and outgoing telephone calls in a list, the telephone data at least including public telephone data, *limiting list access to public telephone data in the list, until such time as a user of the telephone inputs a personal secret access code, after which, the user has access to the public telephone data in the list of public telephone data and private telephone data in a list of private telephone data that is associated with the inputted personal secret access code*, wherein both the private telephone

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data and the public telephone data are stored in the telephone, and/or a memory that stores telephone data related to at least one of incoming and outgoing telephone calls and a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code, access to said stored telephone data being limited to a public list containing public telephone data, until such time as the user enters said personal secret access code, after which, the user has access to said public telephone data contained in said public list and a private list containing private telephone data that is associated with said inputted personal secret access code, wherein both the private telephone data and the public telephone data are stored in the telephone, and/or entering a personal secret access code into the telephone by a user of the telephone, creating a private list containing telephone numbers associated with the personal secret access code entered by the user, the telephone numbers contained in the private list being accessible after entry of the associated personal secret access code, and creating a public list containing telephone numbers that is accessible by any user of the telephone without the need for entering a personal secret access code, wherein the telephone numbers in both the private list and the public list are stored in the telephone, and/or storing in the telephone public type of telephone data related to at least one of incoming and outgoing telephone calls, storing in the telephone, for each of the plurality of users, private type of telephone data related to at least one of incoming and outgoing telephone calls, allowing each of the plurality of users to access to the public type of

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telephone data, preventing each of the plurality of users from accessing the private type of telephone data until each of the plurality of users enters a personal secret access code, allowing one of the plurality of users to access the private type of telephone data upon input of a personal secret access code, and allowing another of the plurality of users to access the private type of telephone data upon input of a personal secret access code, wherein each of the plurality of users has a different personal secret access code, and wherein the private type of telephone data that is accessible by the one of the plurality of users comprises telephone data that is different from the private type of telephone data that is accessible by the other of the plurality of users.

Thus, Applicant submits that at least claims 1, 11, 16 and 23 are not disclosed by any proper reading of YAMANE.

Applicant notes that, for an anticipation rejection under 35 U.S.C. § 102(b) to be proper, each element of the claim in question must be disclosed in a single document, and if the document relied upon does not do so, then the rejection must be withdrawn.

Because this document fails to disclose at least the above mentioned features as recited in independent claims 1, 11, 16 and 23, Applicant submits that this document does not disclose all the claimed features recited in at least independent claims 1, 11, 16 and 23.

Further, claims 2-9, 12, 17-19 and 24 are allowable at least for the reason that these claims each depend from an allowable base claim and because these claims recite additional

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features that further define the present invention. In particular, Applicant submits that no proper reading of YAMANE discloses or even suggests, in combination: that the method further comprises displaying on a display associated with the telephone at least one of the list of public telephone data and the list of private telephone data as recited in claim 2; that the list of public telephone data comprises a public list and the list of private telephone data comprises a private list as recited in claim 3; that the inputting of a personal secret access code comprises manipulating a predetermined key sequence on a keypad of the telephone to initiate an operation to enter the personal secret access code as recited in claim 4; storing the public telephone data and the private telephone data in the respective lists of public telephone data and private telephone data on a common list, the private telephone data being hidden from the user until the user inputs the personal secret access code as recited in claim 5; that the method further comprises providing two operating modes of the telephone, a first mode that has no access restrictions, and a second mode with access restrictions as recited in claim 6; that the method further comprises rejecting an incoming call, and blocking of any indication of the incoming call, when a telephone number is designated as a protected telephone number as recited in claim 7; that the method further comprises switching between the two operating modes by manipulating a predetermined keyboard command as recited in claim 8; that the predetermined keyboard command comprises manipulating one of a particular sequence of commands and a plurality of contemporary commands as recited in

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claim 9; that the telephone further comprises a display that provides a visual indication of at least one of said public telephone data contained in said public list and said private telephone data contained in said private list as recited in claim 12; that the method further comprises preventing the user from being notified of an incoming call when the telephone number of the incoming call is designated as a private telephone number and the user that designated the incoming call as a private telephone number is not a current user of the telephone as recited in claim 17; that the method further comprises storing a plurality of personal secret access codes, the telephone numbers in the private list being associated with various personal secret access codes, a current personal secret access code entered into the telephone by a current user being limited to accessing telephone numbers in the private list that are associated with the current personal secret access code entered by the current user as recited in claim 18; that the method further comprises preventing the current user from being notified of an incoming call when the incoming call is designated as a private telephone number associated with a personal secret access code that differs from that of the current user as recited in claim 19; and a telephone which can be used to practice the method of claim 23, wherein the telephone includes a display, a keypad and a storage device which stores both the public type and the private type of telephone data as recited in claim 24.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection and further requests that the above-noted claims be indicated as allowable.

Traversal of Rejection Under 35 U.S.C. § 103(a)

Applicant traverses the rejection of claims 10, 13-15 and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over YAMANE et al. alone.

The Examiner acknowledges that YAMANE lacks, among other things, inputting an access code, turning off a visual or audible indication, and timed access. However, the Examiner asserted that such features “would be obvious to one of ordinary skill in the art.” Applicant respectfully traverses this rejection.

Notwithstanding the Examiner’s assertion as to what YAMANE discloses or suggests, Applicant submits that in addition to failing to anticipate the invention recited in amended independent claims, YAMANE also fails to teach or suggest the invention recited in at least the independent claims.

Applicant directs the Examiner’s attention to the guidelines identified in M.P.E.P. section 2141 which state that “[i]n determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

As this section clearly indicates, “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

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some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).”

Moreover, it has been legally established that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) Although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’ 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).”

Additionally, it has been held that “[a] statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).”

Moreover, Applicant submits that there is no motivation to modify YAMANE in a manner which would render obvious Applicant's invention, and additionally, Applicant submits that there is no motivation or rationale disclosed or suggested in the prior art to modify the applied reference in the manner suggested by the Examiner. The Examiner's opinion does not provide a proper basis for these features or for the motivation to modify any of these documents, or their combination, in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claims 1, 11 and 16 is not rendered obvious by any reasonable inspection and interpretation of the disclosure of the applied references.

Further, Applicant submits that dependent claims 10, 13-15 and 20-22 are allowable at least for the reason that these claims each depend from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicant submit that no proper combination of the applied documents discloses or suggests, in combination: that the method further comprises delaying the switching between the two operating modes until the user inputs the personal secret access code as recited in claim 10; that the telephone further comprises an inhibitor that prevents at least one of a visual indication and an audible indication of an incoming call when a telephone number of said incoming call is designated to be a private call corresponding to a personal secret access code that has not been inputted into said telephone by a current user of said telephone

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as recited in claim 13; that said personal secret access code is inputted by manipulating a predetermined key sequence on a keypad of said telephone to initiate an operation to enter said personal secret access code as recited in claim 14; that said personal secret access code is inputted by manipulating a predetermined sequence of simultaneous commands for a predetermined time period on a keypad of said telephone to initiate an operation to enter said personal secret access code as recited in claim 15; that the method further comprises switching between a public operating mode and a private operating mode by manipulating a predetermined command on a keyboard of the telephone as recited in claim 20; that entering the personal secret access code comprises manipulating a predetermined key on a keypad of the telephone for a predetermined period of time to initiate an operation to enter the personal secret access code as recited in claim 21; and that entering the personal secret access code comprises manipulating a predetermined sequence of simultaneous commands on a keypad of the telephone for a predetermined period of time to initiate an operation to enter the personal secret access code as recited in claim 22.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 103(a) and indicate that these claims are allowable.

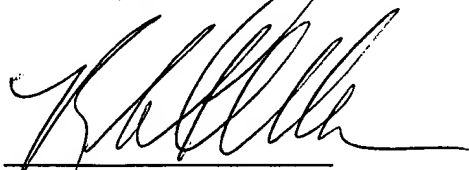
CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious Applicant's invention, as recited in each of the pending claims. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

The U.S. Patent and Trademark Office is hereby authorized to charge any necessary fees in connection therewith or any fees necessary for entry of the instant Amendment to deposit account No. 19-0089.

Respectfully submitted,
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